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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,990	03/28/2005	Hakan Thysell	10400-000119/US	2705
30593	7590	02/21/2006	EXAMINER	
HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 8910 RESTON, VA 20195			RACHUBA, MAURINA T	
			ART UNIT	PAPER NUMBER
			3723	

DATE MAILED: 02/21/2006.

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/506,990

Applicant(s)

THYSELL, HAKAN

Examiner

M Rachuba

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant has only disclosed that there are four grinding disks, and does not disclose that there are more than four grinding disks. The limitation "at least four rotatably supported grinding disks" is not supported by the specification, as the limitation allows there to be more than four disks.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation, "at least four rotatably supported grinding disks" is indefinite, as only four disks have been disclosed, and it is not clear how there may be more than four disks.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Duncan et al, US006238277B1 in view of Godfrey et al, 4,513,469. '277 discloses the claimed invention, including a housing, only supported by two wheels and the rotatably supported grinding disks, the disks being distributed over a planet disk rotatably supported at the bottom of the housing and operatively connected to a motor, and the planet disk being drivable by the motor; and a control unit to control the drive of the device. The wheels are coaxially arranged. '277 discloses that three grinding disks are the preferred embodiment, however, "any plural number of grinders may be employed", column 8, lines 25-26. '277 does not disclose a remote controlled unit, operatively connected via a radio communications unit, or "drive motors, one mechanically connected to each wheel". '469, figure 2 and column 2, lines 13 through column 3, lines 15, teaches providing drive motors, one mechanically connected to each wheel, and the rotation and direction of the wheels controlled via a remote control, radio communications unit. It would have been obvious to one of ordinary skill to have provided '277 with the driven wheels and remote radio control as taught by p469, column 2, lines 13 through column 3, lines 15, to allow an operator to remotely control the device.

***Response to Arguments***

7. Applicant's arguments filed 07 December 2005 have been fully considered but they are not persuasive.

8. Applicant argues that '277 does not disclose at least four grinding disks, or drive motors, one mechanically connected to each wheel or wheel arrangement, and that the teachings of '469 are not analogous to applicant's claimed invention. The examiner respectfully disagrees. '277 discloses as a preferred embodiment the use of three grinding disks. '277 further states that any number of grinding disks may be used, column 8, lines 26-30. Applicant has only claimed at least four grinding disks, applicant has not disclosed or claimed any particular configuration, or placement of the disks that support his contention that the machine is balanced only with at least four disks, or that would lead one of ordinary skill to believe that the number of disks is critical to the functioning of the machine.

9. Applicant further argues that '277 does not disclose that the wheels 14 are driven. The examiner agrees, and relies on the teachings of '469 to supply driven wheels and radio control. '469, in a vacuum cleaner that is used to pick up dust and debris, teaches providing drive motors, *one mechanically connected to each wheel*, and a radio control that controls the speed and direction of rotation of the drive wheels. The radio control allows for the operator to control the device without having to push the device. It is noted that applicant has not disclosed how the wheels are connected to a motor, only that they are. There is no evidence that the device of '469 would not work in a dusty environment, as it is a vacuum cleaner, used to clean up in dusty environments.

10. Applicant further argues that '469 teaches away from the proposed combination with Duncan et al, because applicant alleges that '469 would not function in a dust-laden environment. '469, '469, in a vacuum cleaner that is used to pick up dust and debris, teaches providing drive motors, *one mechanically connected to each wheel*, and a radio control that controls the speed and direction of rotation of the drive wheels.

Applicant has not claimed that there is a motor attached to each wheel, only that one is mechanically connected to each wheel. The radio control allows for the operator to control the device without having to push the device. It is noted that applicant has not disclosed how the wheels are connected to a motor, only that they are connected.

There is no evidence that the device of '469 would not work in a dusty environment, as it is a vacuum cleaner, used to clean up in dusty environments. The radio control allows for the operator to control the device without having to push the device. It is noted that applicant has not disclosed how the wheels are connected to a motor, only that they are. There is no evidence that the device of '469 would not work in a dusty environment, as it is a vacuum cleaner, used to clean up in dusty environments.

11. Applicant charges that the examiner has used improper hindsight in providing the motivation to combine '277 and '469. The examiner strongly disagrees. The motivation is clearly provided by the teachings of '469, that radio control allows the device to function without the operator physically pushing or guiding it. That '469 does not explicitly use the same words as the examiner is expressing that motivation is moot, it is what the prior art teaches as a whole that is relied on by the examiner. MPEP 2143.01 states in part "Obviousness can only be established by combining or modifying the

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teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)." Here, the combined teachings of '277 with '469 implicitly teach that floor grinding machines having any number of grinding disks are known, that floor grinding machines must be moved and guided across the floor surface in order to treat the floor surface, and that radio control allows a device operator "hands-free" operation of the device, without physically pushing or guiding the device. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Conclusion***

12. As the rejections under 35 USC 112 were not made in the previous Office action, this action is made non-final to allow applicant to fairly respond.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Other similar radio controlled floor treating tools are cited of interest, including vacuum cleaners and lawn mowers.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M Rachuba whose telephone number is 571-272-4493. The examiner can normally be reached on Monday-Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571-272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M Rachuba

2/15/06  
M. Rachuba  
Primary Examiner